UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
VIG, NARESH

ART UNIT	PAPER NUMBER
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/849,513	EARNSHAW, DENNIS G.
	Examiner	Art Unit	
	Naresh Vig	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 January 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10 and 14-24* is/are pending in the application.

    4a) Of the above claim(s) *11-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10 and 14-24* is/are rejected.

7)☒ Claim(s) *1,14 and 19* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *20060317* .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

This is in reference to response received on 09 January 2006 to the office action
mailed on 19 September 2005.

Election/Restrictions

In the telephone interview, applicant's attorney has cancelled claims 11 – 13
without traverse. There are 21 claims, claims 1 – 10 and 14 – 24 pending for
examination.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I.   Claims 1 – 10 and 14 – 24 drawn to creating on a first computer an electronic
        business transaction document to be directed to a plurality of recipient parties,
        the electronic business transaction document including a preferred
        communication format indicator for each of the plurality of recipient parties;
        transmitting the electronic business transaction document over the computer
        network to a network-connected transaction service server computer;
        determining at the transaction service server computer a preferred
        communication format for each of the plurality of recipient parties; sending the
        electronic business transaction document from the transaction service server
        computer to a first recipient party using a computer communication format, or,

sending the electronic business transaction document from the transaction

service server computer to a second recipient party using a user preferred non-

computer communication format, based upon determined preferred

communication format of each recipient party, classified in class 705, subclass 1.

II.   Claims 11 – 13, drawn to a business transaction document form identifier for

identifying a business transaction document form corresponding to an electronic

business transaction document; a recipient identifier for identifying each of plural

recipients to whom the electronic business transaction document is directed; a

communication format identifier for each of the plural recipient parties identifying

the preferred communication format for each of the recipient parties, classified in

class 715, subclass 500.

Because these inventions are distinct for the reasons given above and have

acquired a separate status in the art as shown by their different classification, restriction

for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the

search required for one is not required for other groups, restriction for examination

purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have

acquired a separate status in the art because of their recognized divergent subject

matter, restriction for examination purposes as indicated is proper.

Response to Arguments

Applicant is arguing amended claims. Applicant's arguments and concerns with respect to pending claims 1 – 10 and 14 – 24 have been considered and answered in response to the claims.

Claim Objections

Claim 1 objected to because of the following informalities: Claim 1, limitation1 recites limitation as "creating on a first computer an electronic business transaction document to be directed to a plurality recipient parties to a business transaction ......". Examiner reads the limitation as "creating on a first computer an electronic business transaction document to be directed to a plurality of recipient parties to a business transaction ......".

Claim 14 objected to because of the following informalities: Claim 14, limitation1 recites limitation as "software for creating on a first computer an electronic business transaction document to be directed to a plurality recipient parties to a business transaction ......". Examiner reads the limitation as "software for creating on a first computer an electronic business transaction document to be directed to a plurality of recipient parties to a business transaction ......".

Claim 19 objected to because of the following informalities: Claim 19, last sentence of limitation one recites limitation as "wherein the electronic business transaction document is received by a transaction service server computer communicated with the client computer through a computer network". Examiner reads the limitation as "wherein the electronic business transaction document is received by a transaction service server computer communicating with the client computer through a computer network";

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

The omitted steps are: Printing of the business transaction document which is to be mailed to a recipient party.

In response, applicant is required to identify where is the business transaction

document printed, for example at customer site or at transaction service computer in the

missing step.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 7 – 10, 14, 18 – 20 and 23 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Henry US Patent 6,424,426 in view of Akimoto US Patent

6,775,711.

Regarding claims 1 and 14, Henry teaches an electronic business transaction

service method and software in a computer readable medium for conducting a business

transaction over a computer network. Henry teaches:

creating on a first computer an electronic business transaction document to be

directed to a plurality of recipient parties to a business transaction [Fig. 1, 5, 6 and

disclosure associated with Fig. 1, 5, 6], the electronic business transaction document

being created by a business management software program (email), the electronic

business transaction document including a preferred communication format indicator for

each of the plurality of recipient parties of the business transaction [Fig. 6], the

electronic document being directed to at least one recipient party in a computer

communication format [Fig. 6 shows confirmation page with 2 recipients receiving via

email] and to at least one other recipient party in a non-computer communication format

[Fig. 6 shows on the same confirmation sheet third recipient receiving information on

their fax];

transmitting the electronic business transaction document over the computer

network to a network-connected transaction service server computer [Fig. 5 and

disclosure associated with Fig. 5]; and

Henry does not explicitly teach determining at the transaction service server

computer a preferred communication format for each of the plurality of recipient parties

of the business transaction. However, Akimoto teaches determining at the transaction

service server computer a preferred communication format for each of the plurality of

recipient parties of the business transaction, the preferred communication format being

determined by an electronic business management software residing at the transaction

service server computer that interprets the preferred communication format indicator of

each of the plurality of recipient parties of the business transaction [Akimoto, Fig. 8 and

disclosure associated with Fig. 8];

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henry as taught by Akimoto to make it possible to add a plurality of new functions with minimal changes to the existing system.

Henry in view of Akimoto teaches if the transaction service server computer determines that the preferred communication format of a recipient party is a computer communicating format, sending the electronic business transaction document from the transaction service server computer to a first recipient party using a computer communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8]; and

if the transaction service server computer determines that the preferred communication format of a recipient party is a non-computer communicating format, sending the electronic business transaction document from the transaction service server computer to a second recipient party using a user preferred non-computer communication format, wherein the user preferred non-computer communication format can be telephonic facsimile or regular mail [Akimoto, Fig. 8 and disclosure associated with Fig. 8];

Regarding claim 19, Henry teaches electronic business transaction service method for conducting a business transaction over a computer network. Henry teaches:

receiving from a client computer an electronic business transaction document that is compatible with a business management software program [Fig. 5 and disclosure associated with Fig. 5], the electronic business transaction document being directed in one or more communication formats to plural recipient parties to a business transaction

[Fig. 1, 5, 6 and disclosure associated with Fig. 1, 5, 6], the electronic business

transaction document being created by a business management software program in

the client computer (e.g. email) the electronic business transaction document including

a preferred communication format indicator for each of the plurality of recipient parties

of the business transaction [Fig. 6], wherein the electronic business transaction

document is received by a transaction service server computer communicating with the

client computer through a computer network [Fig. 5 and disclosure associated with Fig.

5];

Henry does not explicitly teach determining at the transaction services service

server computer a preferred communication format for each of the plurality of recipient

parties of the business transaction. However, Akimoto teaches determining at the

transaction service server computer a preferred communication format for each of the

plurality of recipient parties of the business transaction, the preferred communication

format being determined by an electronic business management software residing at

the transaction service server computer that interprets the preferred communication

format indicator of each of the plurality of recipient parties of the business transaction

[Akimoto, Fig. 8 and disclosure associated with Fig. 8];

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Henry as taught by Akimoto to make it possible

to add a plurality of new functions with minimal changes to the existing system.

Henry in view of Akimoto teaches that if software residing at the transaction

service server computer that interprets the preferred communication format indicator of

each of the plurality of recipient parties of the business transaction, and

if the transaction service server computer determines that the preferred business

transaction document communication format of a party is a computer communication

format, sending the electronic business transaction document from the transaction

service server computer to a first recipient party using a computer communication

format [Akimoto, Fig. 8 and disclosure associated with Fig. 8]; and

if the transaction service computer determines that the preferred business

transaction document communication format of a party is a non-computer

communication format, sending the electronic business transaction document form the

transaction service server computer to a second recipient party using a non-computer

communication format [Akimoto, Fig. 8 and disclosure associated with Fig. 8].

Regarding claims 2 and 20, Henry in view of Akimoto teaches preferred

communication format includes telephonic facsimile.

Regarding claim 7, as responded to earlier, Henry in view of Akimoto teaches

business management software program is capable of automatically extracting and

populating information from the electronic business transaction document, transmitting

access to the business management software component with the electronic business

transaction document in the computer format to the at least one recipient party, if it is

determined that the at least one recipient party is not capable of viewing the electronic

business transaction document, the business management software component not

being capable of automatically populating and extracting information from electronic

business transaction documents (obvious to one of ordinary skill in the art at the time

the invention was made that if a user does not have capability for handling electronic

file, they will not be able to view the electronic file, for example, a user with computer

environment which does not have graphic capability will not be able to recreate graphics

to be displayed on their computer).

Regarding claims 8 – 9, Henry in view of Akimoto teaches capability wherein the

electronic business transaction document can include a markup language or Extensible

Markup Language as content in the computer file.

Regarding claims 10 and 18, as responded to earlier, Henry in view of Akimoto

teaches capability wherein business transaction can be related to a construction project.

Regarding claim 23, Henry in view of Akimoto teaches capability for manually

changing the preferred communication format automatically associated with the

recipient party prior to sending the electronic business transaction document to a

recipient party [Akimoto, Fig. 8 and disclosure associated with Fig. 8].

Claims 3 - 6, 15 – 17 and 21 – 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Henry US Patent 6,424,426 in view of Akimoto US Patent 6,775,711

and further in view of NetGram.com hereinafter known as NetGram.

Regarding claim 3, Henry in view of Akimoto does not explicitly teach the

preferred communication format includes regular mail, a printed copy of the electronic

business transaction document is mailed to a recipient party. However, Henry in view of

Akimoto teaches plurality of tags can be used to indicate different type of delivery

means for a recipient [Akimoto, Fig. 7, 8 and disclosure associated with fig. 7, 8]. Also, it

is known at the time of invention to one of ordinary skill in the art that businesses have

mailed printed copy of business transaction document to recipient party. However,

NetGram teaches services for sending sender's electronic document via postal mail to

recipient of the document [NetGram page 11 – 13].

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Henry in view of Akimoto as taught by NetGram

to allow senders outsource mailing of their business documents.

Regarding claims 4, 15 and 21, Henry in view of Akimoto does not explicitly

teach storing in an electronic address book address information for each party and the

preferred communication format indicator for each of the plurality of recipient parties of

the business transaction indicating the one of the computer and non-computer

communication formats in which to transmit communications to the party. However,

NetGram teaches address book address information for each party and the preferred

communication format indicator for each of the plurality of recipient parties of the

business transaction [NetGram page 4].

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Henry in view of Akimoto and use address book

of NetGram to store preferred communication format indicator for each recipient parties

to allow the senders to reuse previously stored addresses in the electronic address

book. For example, email services like AOL which teaches address book for their

subscribers.

Regarding claims 5, 16 and 22, Henry in view of Akimoto and NetGram teaches

adding a recipient party to the electronic business transaction document automatically

associates with the recipient party the preferred communication format indicator.

Regarding claims 6, 17 and 24, Henry in view of Akimoto does not explicitly

teach charging a fee for each recipient party to which the electronic business

transaction document is sent from the transaction service server computer. However,

NetGram teaches to charge fee to sender [NetGram 9].

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to modify Henry in view of Akimoto as taught by NetGram

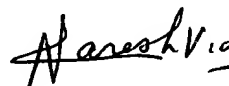and start charging fee to recover operational costs.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CRF '1.111 (c) to consider the references fully when responding to this office action.

1. Maxwell US Patent 5,805,810

2. Akimoto Japan Patent JP02000285042A

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Naresh Vig
Examiner
Art Unit 3629

March 17, 2006